

REMARKS

In the Restriction Requirement mailed June 28, 2006, the Examiner has restricted the claims to one of the following patentably distinct species:

1. Claims 19-21 and 66-75,
2. Claims 28-33, 54-58 and 64-65,
3. Claims 34-38 and 59-63, and
4. Claims 43-44 and 47-53.

Applicant respectfully traverses the instant restriction requirement. Applicant submits that claims 19-21, 28-38, and 43-75 are currently pending in the instant application, though the Office Action Summary incorrectly lists 19-21, 28-38, and 43 and 44 as pending.

M.P.E.P. § 803 states:

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

A Notice of Allowance with respect to claims 19-21, 28-38, and 43-75 of the instant application was issued by the Patent and Trademark Office (PTO) on 22 May 2000. Subsequently, approximately 10 Notices of Allowance were issued with respect to these claims. In each instance, prosecution was continued due essentially to filing requests for continued examination to file information disclosure statements to satisfy a duty to disclose as required by 37 CFR §1.56. M.P.E.P. § 609 states, in part,

In nonprovisional applications filed under 35 U.S.C. 111(a), applicants and other individuals substantively involved with the preparation and/or prosecution of the application have a duty to submit to the Office information which is material to patentability as defined in 37 CFR 1.56. The provisions of 37 CFR 1.97 and 37 CFR 1.98 provide a mechanism by which patent applicants may comply with the duty of disclosure provided in 37 CFR 1.56. Applicants and other individuals substantively involved with the preparation and/or prosecution of the patent application also may want the Office to consider information for a variety of other reasons; e.g., to make sure that the examiner has an opportunity to consider the same information that was considered by these individuals, or by another patent office in a counterpart or related

patent application filed in another country.

...

The filing of an information disclosure statement shall not be construed as a representation that a search has been made. 37 CFR 1.97(g). There is no requirement that an applicant for a patent make a patentability search. Further, the filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56(b), 37 CFR 1.97(h). See MPEP § 2129 regarding admissions by applicant.

As can be taken from these quoted sections, Applicant submits that materials may be cited in an information disclosure statement to "make sure that the examiner has an opportunity to consider the same information" as the Applicant, even though the Applicant may not consider the cited information to be material to patentability.

Applicant submits that if the PTO issues a Notice of Allowance with respect to claims 19-21, 28-38, and 43-75, then these claims have been examined. Further, Applicant submits that the PTO issue of a Notice of Allowance after 10 separate examinations is objective evidence that there is no serious burden on the Examiner to examine all the instant claims in the present application. Serious burden on the examiner is a required criterion for a proper restriction. See, MPEP 803. Applicant respectfully requests removal of the Restriction Requirement and allowance of the instant claims.

Applicant provisionally elects, with traverse, Group I, having at least claims 19-21 and 66-75 readable thereon. Applicant respectfully reserves the right to reintroduce the non-elected claims for reconsideration in this application upon the allowance of a linking claim or to reintroduce them in one or more divisional applications at a later date.

RESPONSE TO RESTRICTION REQUIREMENT

Serial Number: 09/135,413

Filing Date: August 14, 1998

Title: METHOD FOR OPERATING A MEMORY DEVICE HAVING AN AMORPHOUS SILICON CARBIDE GATE INSULATOR

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Dkt: 303.354US2

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2157 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

LEONARD FORBES ET AL.

By their Representatives,

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Date 26 July 2006 By David R. Cochran
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 26 day of July 2006.

Kate Gannon
Name

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Signature